

REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 6 -

December 10, 2007

**REMARKS**

This is in response to the Office Action dated August 22, 2007. Reconsideration is respectfully requested.

Request for Extension of Time

Applicants request that the time period for response be extended one month, from November 22, 2007 to December 22, 2007. Applicants hereby authorize credit card payment for the one-month extension in the amount of \$60 pursuant to 37 CFR 1.17(a)(1).

Request for Continued Examination

In view of the finality of the present Action, applicants submit herewith a Request for Continued Examination pursuant to 37 CFR 1.114. Applicants authorize credit card payment of the associated fee of \$405 pursuant to 37 CFR 1.17(e).

Status of Claims

Claims 1, 2 and 19-23 and 25-36 are pending and all are rejected. Claims 1, 21, 23, 25, 27, 28, 32 and 36 are rejected as anticipated by Australian Patent AU-A-13469/95 to Madsen. Claims 2, 19, 20, 29-31, 33 and 35 are rejected as obvious over Madsen in view of U.S. Patent No. 4,436,119 to Shahan et al. Claim 26 is rejected as obvious over Madsen in view of U.S. Patent No. 2,928,565 to Glasoe, Jr. Claim 22 is rejected as obvious over Madsen in view of U.S. Patent No. 3,523,395 to Rutter et al. Claim 34 is rejected as obvious over Madsen in view of Shahan et al and further in view of U.S. Patent No. 6,399,186 to Matthews et al. Claims 1, 2, 19-21, 23, 25, 27-33, 35 and 36 are rejected as obvious over Shahan et al in view of Madsen. Claim 22 is rejected as obvious over Shahan et al in view of Madsen and further in view of Rutter. Claim 26 is rejected as obvious over Shahan et al in view of Madsen and further in view of Glasoe Jr.

REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 7 -

December 10, 2007

Claim 34 is rejected as obvious over Shahan et al in view of Madsen and further in view of Matthews et al.

Claim 20 is rejected as indefinite for reciting that the fastening system extends between the outer surface layer through the insulation layer to the supporting mesh, which the Examiner finds contradictory to the recitations of Claim 1.

Amendment to Claim 20

Applicants have amended Claim 20 to recite that a fastener extends between the outer surface layer through the insulation layer to the support mesh. This fastener is different from the "mounting means" recited in Claim 1, as indicated by its introduction using the indefinite article "a". Support for this amendment may be found in Figures 1 and 2 of the application, which show a fastener 10 extending between the outer surface layer 3 through the insulation layer 5 to the support mesh 18. Applicants note that the term "fastening system" is no longer recited in Claim 1 as amended in the reply of January 24, 2007 and has, with the amendments provided herein, been deleted from Claim 20. The amendment of Claim 20 establishes proper antecedent basis for all terms used therein and should eliminate any source of confusion perceived by the Examiner.

The Argument

Applicants respectfully traverse the rejections contending that the cited references fail to meet the criterion necessary to support a rejection of the claims as anticipated and also fail to meet the requirements necessary to establish a *prima facie* case of obviousness. Applicants' position is explained in the arguments presented below.

REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 8 -

December 10, 2007

Claim 1

Independent Claim 1 is rejected as anticipated by Madsen. However, Claim 1 recites, in relevant part, a "mounting means extending from the panel for mounting the panel on the outer wall of the process vessel at a distance therefrom to define an air gap between the panel and the outer wall of the process vessel when the insulation module is mounted relative thereto". Madsen does not disclose the recited structure, but as shown in Figure 7 thereof, Madsen discloses an air gap 14 positioned between a panel (layers 4 and 15) and another insulation layer 3, and not the outer wall of item 1, which the Examiner interprets as being analogous to the "process vessel" recited in Claim 1 (item 1 is in fact, not a process vessel, but is defined in Madsen as a "wall structure", the context of Madsen suggesting the wall structure of a building). However, allowing, for the sake of argument only, that item 1 in Figure 7 of Madsen is the wall structure of a process vessel, Madsen does not show an insulating arrangement wherein an air gap is positioned between the panel and the outer wall of the process vessel. There is clearly an intervening insulating layer 3. Applicants' invention specifically avoids this configuration wherein an insulating layer is mounted on the process vessel outer surface as stated in the application on page 2, lines 18-21:

The provision of the air gap leads to a number of advantages:

(a) because the insulation layer is separated from the wall of the vessel by the air gap, this minimizes the possibility of corrosion due to the retention of moisture within the insulation layer...

Madsen clearly does not disclose applicants' invention because it places an insulation layer 3 directly against the outer surface of the item being insulated, thus inviting corrosion if item 1 were a process vessel (which it is not).

REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 9 -

December 10, 2007

In order to better distinguish Claim 1 over Madsen, applicant has amended Claim 1 to further recite "there being no intervening insulation layer mounted on said outer wall between said outer wall and said panel" consistent with the aforementioned teachings regarding corrosion on page 2 of the application.

To anticipate a claim, the reference must teach every element of the claim. Clearly, Madsen fails to meet this criterion because it fails to teach a structure having "mounting means extending from the panel for mounting the panel on the outer wall of the process vessel at a distance therefrom to define an air gap between the panel and the outer wall of the process vessel when the insulation module is mounted relative thereto, there being no intervening insulation layer mounted on said outer wall between said outer wall and said panel". Applicants contend that Claim 1 is allowable over Madsen and request that the rejection of Claim 1 as anticipated by Madsen be withdrawn.

Claims 21, 23, 25, 27, 28, 32 and 36 depend, either directly or indirectly, on Claim 1 and should be allowable for the same reasons that Claim 1 is allowable over the cited references.

Claims 2, 19, 20, 29-31, 33 and 35 are rejected as obvious over Madsen in view of Shahan et al. The Examiner cites Shahan et al only for its supposed teaching of particular recitations of various elements found in the dependent Claims 2, 19, 20, 29-31 and 35 (elements such as fibrous insulation, support mesh, etc.), contending that Madsen discloses all of the recited structure of Claim 1. However, Claims 2, 19, 20, 29-31, 33 and 35 all depend, either directly or indirectly, upon Claim 1, and therefore, each dependent claim has all of the recitations of Claim 1. It was

REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 10 -

December 10, 2007

shown above that Madsen, contrary to the Examiner's assertion, does not disclose the structure recited in Claim 1, namely, Madsen fails to disclose "mounting means extending from the panel for mounting the panel on the outer wall of the process vessel at a distance therefrom to define an air gap between the panel and the outer wall of the process vessel when the insulation module is mounted relative thereto, there being no intervening insulation layer mounted on said outer wall between said outer wall and said panel" as recited in Claim 1. Therefore, since Madsen does not teach or suggest all recitations of Claim 1, and Shahan et al is cited only for its teachings of what is in the dependent claims, the combination of Madsen and Shahan et al does not teach or suggest all of the recitations of dependent Claims 2, 19, 20, 29-31, 33 and 35.

One of the three criteria necessary to establish a *prima facie* case of obviousness requires that the reference, or references when combined, must teach or suggest all claim recitations. As demonstrated above, the combination of Madsen and Shahan et al fail to meet this requirement because the combination of references fails to teach or suggest the mounting means configured as recited in Claim 1. Since the dependent Claims 2, 19, 20, 29-31, 33 and 35 also include the recitations of Claim 1, the cited references fail to meet the requirements necessary to establish a *prima facie* case of obviousness for the dependent Claims 2, 19, 20, 29-31 and 35, and therefore, these dependent Claims should also be allowable over the cited references for the same reasons that Claim 1 is allowable, i.e., all claim recitations are not taught or suggested.

Claims 22, 26 and 34 are rejected as obvious over Madsen combined with another cited reference. For Claim 22, Madsen and Rutter are cited; for Claim 26, Madsen and Glasoe, Jr. are

REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 11 -

December 10, 2007

cited; for Claim 34, Madsen, Shahan et al and Matthews et al are cited. The references Rutter, Glasoe, Jr., Shahan et al and Matthews et al are each cited as teaching specific recitations found in the aforementioned dependent claims, and not for teaching the recitations of their base Claim 1. However, Claims 22, 26 and 34 all depend, either directly or indirectly, upon Claim 1 and therefore incorporate all of the recitations of Claim 1. Madsen is cited as teaching the recitations of Claim 1, but as shown above, Madsen fails to teach or suggest every recitation of Claim 1. Therefore, by the same reasoning as provided above for Claims 2, 19, 20, 29-31, 33 and 35, the cited combinations of Madsen and Rutter, Madsen and Glasoe, Jr. and Madsen, Shahan et al and Matthews et al each fail to meet the requirements necessary to establish a *prima facie* case of obviousness for respective Claims 22, 26 and 34 because none of these combinations teaches or suggests all claim recitations of these claims, i.e., the references, when combined, fail to teach or suggest all claim limitations of at least Claim 1, and by logical extension each of its dependent Claims 22, 26 and 34 since the dependent claims include all of the recitations of Claim 1. Claims 22, 26 and 34 should be allowable over the cited references.

Claim 1 is also rejected as obvious over Shahan et al in view of Madsen, the Examiner contending that this combination of references teaches or suggests all recitations of Claim 1. The Examiner admits that Shahan et al fails to teach or suggest the mounting means directly securing the outer wall to the panel, but contends that such direct securing is taught in Madsen. The Examiner concludes that it would be obvious to modify Shahan et al by the teachings of Madsen and make the mounting means of Shahan et al from a single structure to directly connect the panel to the outer wall as taught in Madsen.

REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 12 -

December 10, 2007

However, it should be noted that the mounting 22 in Shahan et al is intentionally designed to include a plurality of components which indirectly secure the outer wall 11 to the panel 10. Specifically, the mounting 22 is an isolator which includes a damper 27 which serves to acoustically isolate the outer wall from the panel as described at column 2, lines 21-23:

"To completely eliminate any acoustical vibrations from being transmitted from the piping 11 to the lagging 12, there is provided a series of isolators 22."

Column 2, lines 49-53 further clarify the purpose of the mounting design in Shahan et al:

"By this construction the isolator 22, as it extends between the inner lining 14 and the lagging 12, will function to secure the insulation 13 upon the inner surface of the lagging 12, with a minimum physical contact between vibration transmitting members."

Thus, if the mounting as taught in Shahan et al were modified to form a single structure "to directly connect the panel to the outer wall" as proposed by the Examiner, then the isolators 22 and their dampers 27 would be eliminated and the acoustical damping function of the mounting would be thwarted. "The proposed modification cannot render the prior art unsatisfactory for its intended purpose" (MPEP, Section 2143.01). Clearly, modifying Shahan et al to directly secure the outer wall to the panel would be totally against the express teachings of this reference and render it unsatisfactory for its intended purpose of providing acoustic isolation. In the face of this knowledge, there is no logical reason why one would modify the mounting of Shahan et al as proposed by the Examiner, knowing that it would negate an

REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 13 -

December 10, 2007

expressly intended characteristic of the mounting, specifically, the acoustic or vibration damping capabilities. According to KSR International Co. v. Teleflex Inc., 550 U.S. at \_\_\_, 82 USPQ2d 1385, the Examiner is required to provide a clear articulation of the reasons why the claimed invention would have been obvious; there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness (see "Examination Guidelines for Determining Obviousness under 35 USC 103 in view of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.", Federal Register/Vol. 72, No. 195). Applicants contend that there can be no "rational underpinning" for a proposed modification which renders the prior art unsatisfactory for its intended purpose. Applicants request that the Examiner explain why it would be rational to go against the express teachings of Shahan et al and convert the acoustically isolating mountings disclosed therein into a single structure which would negate the acoustical isolating function of the mountings and thereby render these mountings unsatisfactory for their expressly intended purpose. Applicants contend that the combination of Shahan et al and Madsen fails to meet the criteria necessary to establish a *prima facie* case of obviousness because a rational underpinning which justifies the proposed combination and modification is lacking.

Claims 2, 19-21, 23, 25, 27-33, 35 and 36 depend, either directly or indirectly, on Claim 1 and should be allowable over the cited references for the same reason that Claim 1 is allowable.

Claim 22 depends indirectly on Claim 1 and includes all of the recitations of Claim 1. Claim 22 is rejected as obvious over Shahan et al in view of Madsen as applied to Claim 1 and further in view of Rutter. However, Rutter is cited only for its teaching of a particular type of connector,



REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 14 -

December 10, 2007

and it was shown above that a rational underpinning is lacking which justifies modifying Shahan et al by the teachings of Madsen to achieve the recitations of Claim 1. Therefore, Claim 22 should be allowable over the combination of Shahan et al, Madsen and Rutter for the same reasons that Claim 1 is allowable. Similar arguments may be made against the rejections of Claims 26 and 34. Both depend indirectly on Claim 1. Again, the rejections for Claims 26 and 34 depend upon Shahan et al in view of Madsen as applied to Claim 1, which was shown to lack a rational underpinning justifying a conclusion of obviousness. Claims 26 and 34 should also be allowable for the same reasons that Claim 1 is allowable over the cited references.

Summary

Applicants have demonstrated, in the arguments presented above, that the cite references fail to meet the criterion needed to support a rejection on the basis of anticipation because all claim elements are not taught. Applicants have also demonstrated that the cited references do not meet the requirements necessary to establish a *prima facie* case of obviousness, either because the references fail to teach or suggest all claim limitations or there is no rational underpinning supporting the legal conclusion of obviousness, since the proposed modification contradicts the express teachings of one of the references and renders it unsatisfactory for its intended purpose.

REPLY TO FINAL OFFICE ACTION  
DATED AUGUST 22, 2007

Appln. No. 09/744,351

- 15 -

December 10, 2007

In view of the arguments presented above, applicants contend that the claims are allowable and request that the rejections be withdrawn and the application passed to issue.

Respectfully submitted,

SYNNESTVEDT & LECHNER LLP

By:



John A. Chionchio  
Reg. No. 40,954

1101 Market Street, Suite 2600  
Philadelphia, PA 19107-2950  
Telephone: (215) 923-4466  
Facsimile: (215) 923-2189

JAC/dml